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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

JESSOP, *et al.*

Serial No.: 09/196,524

Parent Filed: November 20, 1998.

CPA Filed: May 20, 2002

For: **PIPETTE TIP PACKAGING
AND TRANSFER SYSTEM**

Group Art Unit: 1743

Examiner: HANDY, D.

Atty. File No.: 45825-01012

CERTIFICATE OF EXPRESS MAIL

I hereby certify that this correspondence is being sent
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VA 22313 this 21st day of November, 2003.

Holme Roberts & Owen LLP

By Teresa K. Burgon

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OFFICE OF PETITIONS

PETITION TO REVIVE

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Madam/Sir:

Pursuant to 37 C.F.R. § 1.137 (a) and (b), Applicants hereby petition to revive the above-referenced application. The reason for the delay in responding was unintentional and is also believed to be unavoidable.

The application was deemed abandoned in a notice of abandonment mailed March 19, 2003. The reason for abandonment was failure to respond to an office action mailed July 2, 2002.

12/17/2003 AKELLEY 00000011 082665 09196524

01 FC:2452 55.00 DA
02 FC:2453 665.00 DA

Applicants' counsel was unable to locate the office action. While waiting for a copy in response to an oral request for a copy, a copy of the missing office action was recently found. Thus, Applicants are now able to proceed.

CHRONOLOGY/BACKGROUND

This is a Continuing Prosecution Application (CPA) filed on May 20, 2002.

On May 20, 2002, applicant submitted a preliminary amendment which apparently was received by the Patent Office and was apparently entered before examination.

On July 2, 2002, an Office Action was mailed by the Patent Office. This Office Action must have been received by Applicants' counsel, but it is apparent that it was not processed correctly so that its existence was not known to the undersigned counsel. Failure to respond to this Office Action has led to the abandonment from which relief is now sought.

On October 29, 2002, a Second Preliminary Amendment was submitted to the Patent Office and apparently was received by the Patent Office.

On or about March 5, 2003, a telephone call was made to the Patent Office by the Assistant to Applicant's Counsel to obtain the status of the application. She had a conversation with the Examiner who reported that he had received but not entered the Second Preliminary Amendment. He reported that the Office Action of July 2, 2002 had been issued. Applicant's Assistant had the file in front of her. She looked for the Office Action of July 2, 2002 and could not find it in the file. So she then informed the Examiner that the Office Action of July 2, 2002 was not on hand and apparently had not been received by this office. She then asked the Examiner if he would simply reissue the Office Action of July 2, 2002. He indicated that he

would not, and that he would shortly be issuing a Notice of Abandonment. The Assistant then asked the Examiner to supply a copy of the Office Action; and he said that he would.

The Notice Of Abandonment which the Examiner said would be issued was mailed on March 19, 2003 and received on March 27, 2003.

The requested copy of the Office Action has never been received and ostensibly was never sent. While waiting for the requested copy, Applicants' counsel and his staff began a search looking for the missing Office Action on the assumption that it may have been received but misplaced. Files searched included all the files for this client. Mr. Jessop was then an employee of MEDAX, Inc. which is the client. MEDAX, Inc. has a number of other matters with this firm all of which are being handled by the undersigned counsel. The files for each of these matters was searched with no evidence of the missing Office Action. Applicants' counsel thus waited for the missing Office Action requested from the Examiner.

The firm relocated its offices in September 2002. Considerable turmoil was introduced into firm administration and into the filing system starting in July and extending into September 2002. Knowing this, Applicants' counsel asked his assistant to follow up on why we had not obtained a copy of the missing office action in the summer.

For a period prior to February, 2003, an associate (registered patent attorney) had assisted the undersigned counsel in many patent office matters including this matter. He had prepared drafts of documents submitted to the Patent Office in several cases and supplied them to the undersigned for approval. In this case, he assisted by preparing drafts of several of the more recent documents including claims 10-14 as originally submitted. The associate left the employ of this firm in February, 2003. At that time of his departure, the undersigned and the associate

together went through all of the associate's papers, binders and things in the associate's office that related to any ongoing projects with which he was involved. A list of active matters had been prepared and was reviewed in detail. There were no MEDAX matters discussed.

In September of 2003, an unmarked file was brought up to the desk of the undersigned. It has "patent related materials" in it but was not associated with a file. It was sent to me with the idea that the undersigned (as the only then existing patent attorney in this office) could determine what it was and if it was of value to tell the staff where to file it. The totally unmarked file folder contained a black three ring binder that contained a copy of the missing Office Action, the previous office action, an as-filed application and a copy of the primary reference. Where the file had been and how it came to be found is simply unknown. Given the context, it is believed that it was misfiled. How it came to be discovered is not known. It was not in the materials discussed with the associate before he left. Nonetheless, it surfaced some 6 months after he left.

It was an observable habit of the associate to assemble pertinent documents into a three ring binder. This, in fact, was a practice that had been suggested by the undersigned in the mentoring process. It was also an observed fact that the associate would from time to time take incoming mail for action before it was properly docketed or distributed. While he had been asked to not do that, he appears to have done so in this case leading to this very kind of situation which we all seek to avoid.

Given that the associate was involved in preparing the first draft of everything that had been sent to the patent office in connection with this case in the year or so prior to the arrival of the Office Action of July 2, 2002, he presumably saw the office action when the secretary was not at her desk and picked it up for action. The undersigned has asked the associate (because we

have remained in contact) who reported that he remembered the binder, but had no memory about the office action in question. The undersigned thus believes that the associate saw the office action in the incoming mail, took it to keep his binder current, had copies made, sent a copy back to the secretary by interoffice mail in or about August, 2002. The interoffice mail may have been disrupted, or the item lost after it made its way to the secretary. In short, in the turmoil connected with the move, the Office Action was lost. In turn, the Office Action was not in the file, was not docketed and was not responded to in a timely manner. The original has never been located.

REMARKS

Petition

Applicants herein petitions to revive the above referenced application as unintentionally abandoned. In the alternative applicants petition to revive on the grounds that the application was unavoidably abandoned. In an abundance of caution, applicant is proceeding to authorize payment on the basis that the application was unintentionally abandoned. If the submissions are deemed to show unavoidable, then it is requested that the lesser fee be charged to the deposit account 08-2665.

Under 37 C.F.R. § 1.137 (b), an applicant may seek revival of an unintentionally abandoned application by petition by submitting:

- (a) The required response to the outstanding Office Action.
- (b) The petition fee of \$665 under 37 C.F.R. § 1.17(m).
- (c) A showing to the satisfaction that the delay in responding was unintentional.

(d) A terminal disclaimer under 37 C.F.R. § 1.137 (d).

As will be seen hereinafter, Applicants are submitting all that is required. In the alternative and preferably, Applicants seek revival of this application on the grounds that it was unavoidably abandoned. Under 37 C.F.R. § 1.137 (a), an applicant may seek revival of an unavoidably abandoned application by petition by submitting:

(a) The required response to the outstanding Office Action.

(b) The petition fee of \$55 under 37 C.F.R. § 1.17(l).

(c) A showing to the satisfaction that the delay in responding was unavoidable.

(d) A terminal disclaimer under 37 C.F.R. § 1.137 (d).

If the requisite showing has been made to support a finding that the abandonment was unavoidable, then Applicants request that such a finding be made and the lesser fee of \$55 charged under 37 C.F.R. § 1.17(l).

Required Response

Applicant's staff asked for a copy of the Office Action of July 2, 2002, but if sent, it has never been received. Applicants' counsel located a copy of the missing Office Action in September, 2003 and has now prepared and attached the required response.

Petition Fee

The petition fee of \$665 required by 37 C.F.R. §§ 1.137 (b)(2) and 1.17(m) may be obtained from deposit account 08-2665. If the request of Applicants that that the petition be

deemed to be “unintentional”, then the fee for “unintentional” of \$55 may in the alternative be charged to deposit account 08-2665.

Reason For Delay

The delay in responding arose from the fact that the Office Action of July 2, 2002 was never processed by the secretary of the undersigned who was then and is still assigned to handle all incoming mail for the undersigned including all incoming mail from the United States Patent and Trademark Office. The secretary is a person with leave of 15 years plus experience handling patent matters and has worked with the undersigned directly or indirectly for most of those leave of 15 years. To her memory and the memory of the undersigned, she has never lost an office action.

Because the Office Action of July 2, 2002 was not in the file, both she and the undersigned took it to mean that an office action had not been issued. This is established by the fact that the undersigned counsel had the file before him when he prepared the second preliminary amendment. He would not have sent in a preliminary amendment if there was an office action in the file that has already passed the 6 month statutory response period. It is quite apparent that a preliminary amendment is not a proper statutory response to the Office Action of July 2, 2003.

The fact that the Office Action was not in file and presumed to not have been issued is demonstrated by the fact that the undersigned arranged for his secretary to call for status during which conversation she learned that the Office Action of July 2, 2002 had issued and that the application was about to become abandoned. The Examiner was asked by her to reissue the

Office Action which he refused to do; so she asked for a copy of the office action as reported above which we understood would be sent in due course.

With the Office Action not in the file, an investigation was undertaken to see what had happened. Each file for this client was pulled and checked to see if it was in there. It was not found. This part of the investigation was completed by May, 2003 while we were waiting for the promised copy of the Office Action.

Given that the matter was so “present” as a matter that was in jeopardy, it was not docketed for further action, and the undersigned simply did not pick it up for response while waiting for the copy of the Office Action. The requested copy has not yet been received.

For the period from about November, 2000 to February, 2003, the undersigned had an associate patent attorney assisting him in many different matters. He left the employ of the firm of the undersigned in February of 2003. At the time he left, materials from the associate’s office were collected by the undersigned and reviewed together. The undersigned actually went through many binders and files with the associate before he left and then examined many other files after the associate left to make sure that all matters that the associate had in his office were under control and being timely handled. None of the materials processed at this time related to the present application.

During his tenure, the associate (a relatively new registered patent attorney) had helped the undersigned with this patent application by assisting with other prior communications. It was NOT his case and had NOT been assigned to him as a matter for which he would be totally responsible. Responsibility remained with the undersigned.

As it appears now, the Associate must have seen the Office Action in the mail, pulled it out and proceeded to work on it without ensuring that it was docketed. This conclusion is supported by the fact that a three ring binder having only a copy of the Office Action of July 2, 2002 was found in September, 2003. The binder was unmarked and undated. That binder contained many documents relating to this application one of which is a copy of the July 2, 2002 Office Action. The original copy of the Office Action has not yet been located.

Inasmuch as a copy of the Office Action of July 2, 2002 has been found, a complete petition to revive is now being filed.

The delay in responding to the Office Action of July 2, 2002 is administrative and was not intentional. Indeed, it can be seen that applicant submitted a Second Preliminary Amendment dated October 29, 2002 which was ostensibly within the response period with no mention of the July 2, 2002 communication. If the "Office Letter" mentioned on the Notice of Abandonment is an office action on the merits with rejections or objections, then the preliminary amendment would in deed be indicative that something was amiss and that counsel/applicant had not received the "Office Letter". If the "Office Letter" presented informalities or set forth some other requirement, again the Second Preliminary Amendment would have been indicative of the fact that the "Office Letter" had not been received because it made no mention of it and did not respond to it.

Applicant sought to avoid this petition by asking the Examiner to not issue the Notice of Abandonment but rather to resend the missing Office Letter . See Affidavits of T. Rossa and J. Bawden submitted herewith. The file demonstrated that the communication, whatever it was,

had not been docketed probably because it was diverted by an associate from its normal processing channel.

It is clear that the failure to respond was unintentional. It was accidental and not the result of a deliberate choice to abandon the application. It was also unavoidable because a younger associate must have taken mail in violation of office policy to ensure proper docketing. For whatever reason, he did not follow up to ensure that the action was docketed leading to the ultimate abandonment. There is no way to avoid unauthorized actions of another that are inconsistent with office practice and policy.

Disclaimer

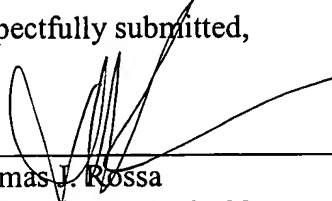
A disclaimer as required by 37 C.F.R. 1.37(d) will be submitted if required. However it seems to be wholly inapplicable in the present situation inasmuch as the delay here will not lead to an extension of the patent period since the priority date remains unchanged and any term extension, if appropriate, may be controlled by the Commissioner under 35 U.S.C. § 154 (b) (3) (C). See also 37 C.F.R. §§ 1.702 to 1.705 and MPEP §§ 2720 and 2730.

CONCLUSION

Please charge any fees not accompanying this communication that may be required to deposit account 08-2665.

If there are questions, the Examiner can reach applicants' counsel at (801) 521-5800 or
by e-mail at rossat@HRO.com.

Respectfully submitted,



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Dated: November 21, 2003
Enclosure: Amendment

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